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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,397	04/11/2000	Hiroshi Satomi	862.C1898	4943
5514	7590	04/15/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LIANG, GWEN	
			ART UNIT	PAPER NUMBER
			2162	
DATE MAILED: 04/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/547,397

Applicant(s)

SATOMI ET AL.

Examiner

GWEN LIANG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-44 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-44 and 47-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04072005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed on 3/14/2005.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39-42, 43, 44, 47-49, 50-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claims 39 and 50, the claimed subject matter, a computer-executable method and a method respectively, is not tangibly embodied in a computer-readable medium, and hence non-statutory. A computer-executable method lacks assured results unless the method is tangibly embodied on a computer-readable medium. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Regarding independent claim 43, the claimed subject matter, an apparatus, does not contain a computer component to be recognized as a computer related invention.

Regarding independent claim 44, the claimed subject matter, a program product, is not tangibly embodied in a computer-readable medium in a manner so as to be executable, and hence non-statutory.

Response to Arguments

3. Applicant's arguments regarding claim 39 that Bowman is not seen to search for first information corresponding to an inputted identification code, wherein the first information has an associated identification code and a keyword which is different from the associated identification code, searching for second information based on the keyword of the searched first information, and outputting the content of the searched first information and the content of the searched second information together have been fully considered but they are not persuasive. As additional grounds of rejections stated for claim 39 in this Office action, Bowman's teaching reads on each and every element as set forth in the claim. See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 39-44, 47-54 are rejected under 35 U.S.C. 102(e) as being anticipated by

Bowman et al., “Bowman” (U.S. Patent No. 6,006,225).

With respect to claim 39, Bowman discloses a method ... comprising:

a first storing step, of storing a first information associated with an identification code in a database (Abstract and col. 2, line 47 – col. 3, line 5);

a first search step, of searching for first information corresponding to an inputted identification code, wherein the first information has a keyword which is different from the identification code associated with the first information (col. 14, lines 13-31 and Figure 9, wherein “OUTDOOR TRAIL” is equivalent to an inputted identification code and the retrieved result set of “OUTDOOR TRAIL-BIKE”, “OUTDOOR TRAIL-SPORTS” and “OUTDOOR TRAIL-VACATION” is equivalent to the first information, wherein the first information has a key word, (for example BIKE), which is different from the identification code “OUTDOOR TRAIL”);

a second search step, of searching for second information based on the keyword of the searched first information (col. 14, lines 26-28, “...the query server 132

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automatically selects the related term at the top of related terms list (such as the term "bike" in the FIG. 9 example), and searches the query result to identify a subset of query result items that include this related term", wherein searching for second information is based on the keyword "bike"); and

an output step, of outputting content of the searched first information and content of the searched second information together (Figure 9, wherein the display includes both the first information and the second information).

Claim 40 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein the first information has a weight value, and said second search step is executed based on the keyword of the searched information and in consideration of the weight value of the keyword (col. 12, lines 42-67).

Claim 41 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein said second search step is executed when an output layout of content of the searched first information is determined (See for example: Fig. 9, wherein the determination of an output layout of the searched first information is inherent in order for this information to be displayed).

Claim 42 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein said second search step is executed based on the keyword of the searched first information and in consideration of at least property information of a user who inputs the identification code or device property information of an output device, which is used to output content of the searched first

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information and content of the searched second information together (col. 12, lines 2-12).

Claim 43 is rejected on grounds corresponding to the reasons given above for claim 39 and furthermore Bowman discloses an apparatus comprising an acquisition unit adapted to acquire an identification code (col. 14, lines 13-15, 'FIG. 9 illustrates a sample query result page 900 in which a user has performed a subject field search on the terms "OUTDOOR TRAIL"', wherein the term "OUTDOOR TRAIL" is equivalent to an identification code);

Claims 47-49 are rejected on grounds corresponding to the reasons given above for claims 40-42.

Claim 44 is rejected on grounds corresponding to the reasons given above for claim 43.

Claims 50-53 are rejected on grounds corresponding to the reasons given above for claims 43, 47-49.

Claim 54 is rejected on grounds corresponding to the reasons given above for claim 39.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GWEN LIANG whose telephone number is 571-272-4038. The examiner can normally be reached on 12:00 P.M. - 8:30 P.M. Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8 April 2005
G.L.


Primary Examiner